

REMARKS

Applicant submits that by the present Amendment and Remarks, this Application is placed in condition for immediate allowance. As will be apparent, no new matter has been introduced and no new issue has been generated as the present Amendment merely addresses a formalistic issue. Accordingly entry of the present Amendment and favorable consideration is solicited pursuant to the provisions of 37 C.F.R. §116.

Claims 1 through 16, and 19 through 36 are pending in this Application. Claims 16 and 35 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, again noting that the present Amendment merely addresses a formalistic issue. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 16 and 35 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter.

In stating the rejection, the Examiner asserted that claims 16 and 35 recite “a computer-readable medium carrying...” that is not a non-statutory subject matter. This rejection is traversed.

Applicant respectfully submits that claims 16 and 35 recite statutory subject matter directed to a computer-readable medium carrying one or more sequences of one or more instructions. MPEP §2106.01 explains that functional descriptive material, such as computer programs, that are recorded on some computer-readable medium becomes structurally and functionally interrelated to the medium and will be statutory in most cases since the use of the

technology permits the function of the descriptive material to be realized. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ 2d 1031, 1035 (Fed. Cir. 1994). Therefore, contrary to the Examiner's conclusions, claims 16 and 35 are directed to statutory subject matter.

In order to expedite prosecution, claims 16 and 35 have been clarified by reciting "a computer-readable **storage** medium **storing**", which is clearly directed to subject matter embraced by 35 U.S.C. §101. Applicant therefore solicits withdrawal of the rejection of claims 16 and 35 under 35 U.S.C. §101.

Claims 1 through 16 and 19 through 36 were rejected under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support.

In the statement of the rejection, the Examiner asserted that the recitation "the interchangeable memory being separated from a SIM card of the mobile device" is not described in the specification. This rejection is traversed.

Initially, literal support is not required by the statute. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67 (Fed.Cir.1997). An applicant need not utilize any particular form of disclosure. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed.Cir.1996)). Further, a patent applicant has the right to narrow an originally disclosed invention. *In re Johnson*, 558 F.2d 1008 (C.C.P.A.). These legal tenants support the determination that one having ordinary skill in the art would have recognized from the originally filed disclosure that Applicant had possession of the claimed subject matter.

Specifically, at least ¶¶ [0032], [0083], and [0086] of the written description of the specification disclose that the interchangeable memory can be a multimedia card (MMC), and ¶¶ [0001], [0014], and [0055] disclose that the interchangeable memory is "hotswappable" i.e. being

inserted/changed to the terminal device without powering the terminal off.” A multimedia card is a flash memory card and hotswappable, while a SIM card securely stores the service-subscriber key (IMSI) used to identify a subscriber on mobile telephony devices (such as mobile phones) and is not hotswappable. In addition, ¶ [0069] discloses that the interchangeable memory retrieves and stores the terminal device ID or a SIM card ID from the mobile terminal device. These paragraphs would have reasonably conveyed to one having ordinary skill in the art that Applicant had possession of the now claimed invention at, including that the limitation “the interchangeable memory being separated from a SIM card of the mobile device”, as recited in claims 1, 12, 19, and 26.

Applicant therefore submits that the imposed rejection of claims 1 through 16 and 19 through 36 under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support is not factually viable and, hence, solicits withdrawal thereof.

Claims 1 though 9, 11 though 16, 19 though 29, and 31 though 36 were rejected as obvious under 35 U.S.C. §103(a) based on *Imaeda* (US 2004/0204093, “*Imaeda*”) in view of *Kelkar* (US 2004/0198456, “*Kelkar*”), *Piikivia* (US 2004/0065734), and *Thomas et al.* (US 6453160, “*Thomas*”).

In stating the rejection, the Examiner asserted that one having ordinary skill in the art would have been led to modify the wireless communication system of *Imaeda*, by including the *Kelkar*’s SIM card, *Piikivia*’s smart cards (separated from a SIM card), and *Thomas*’ gaming application, to provide an efficient communication terminal. Applicant respectfully traverses this rejection.

The claimed inventions employ an independent interchangeable memory to automatically set up a connection between a mobile terminal device and a server via a cellular network

interface of the mobile terminal, and to activate a cellular network application that is independent from a cellular network communication application activated via the SIM card of the mobile device. In particular, the claimed inventions provide an interchangeable memory different from a SIM card (¶¶ [0018]; [0069]; e.g., a multimedia card (MMC)).

Specifically, independent claims 1, 12, 19, and 26 recite, *inter alia*, “detecting that an interchangeable memory has been connected to a mobile terminal device which device includes an interface for connecting an interchangeable memory and a cellular network interface, **the interchangeable memory being separated from a SIM card of the mobile device**; and **automatically** setting up a connection between the mobile terminal device and said server via said cellular network interface and **activating a cellular network application that is independent from a cellular network communication application activated via the SIM card of the mobile device**.”

Applicant respectfully contends that none of the applied references, taken singly or in any combination, disclose or suggest the above-described independent interchangeable memory working in conjunction with a wireless terminal. As admitted by the Examiner, neither *Imaeda* nor *Kelkar* provide the claimed interchangeable memory being separated from a SIM card of the mobile device.

Piikivia was said to provide the interchangeable memory being separated from a SIM card of the mobile device. However, *Piikivia* cannot preclude patentability for obviousness in light of the enactment of the American Inventors Protection Act (AIPA), Pub. L. 106-113, § 4807, effective for all applications filed on or after November 29, 1999. As amended, 35 U.S.C. §103(c) provides:

- (c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the

invention as made, owned by the same person or subject to an obligation of assignment to the same person.

The present Application, as well as its patent PCT Application No. PCT/IB03/02532 from which the present Application claims priority, were both filed after the Nov. 29, 1999 enactment date of this provision of the AIPA and is, therefore, entitled to benefit from the AIPA's prior art exclusion for certain commonly assigned patents. The priority day of the present Application is June 30, 2003, which is within one year of the effective filing date, i.e., Sep. 27, 2002, and before the publication date, i.e., Apr. 8, 2004, of *Piikivia*. Thus, *Piikivia* would qualify as prior art only under subsections (e), (f), or (g) of 35 U.S.C. §102. Since at the time the present invention was made it was owned by or subject to an obligation of assignment to the same person, Nokia Corporation, the use of *Piikivia* in the obviousness rejection is disallowed by law. The fourth reference to *Thomas* does not cure the previously argued deficiencies.

It is therefore apparent that even if the proper applied references are combined as proposed by the Examiner, and Applicant does not agree that the requisite realistic motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). Applicant, therefore, submits that the imposed rejection of claims 1 through 9, 11 through 16, 19 through 29, 31 through 36 under 35 U.S.C. §103(a) for obviousness based on *Imaeda* in view of *Kelkar*, *Piikivia*, and *Thomas* is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 10 and 30 were rejected as obvious under 35 U.S.C. §103(a) based on *Imaeda* in view of *Kelkar*, *Piikivia*, *Thomas* and well known prior art (MPEP 2144.03).

This rejection is traversed.

Specifically, claim 10 depends from independent claim 1, and claim 30 depends from independent claim 26. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 26 under 35 U.S.C. §103(a) for obviousness based on the combined disclosures of *Imaeda*, *Kelkar*, *Piikivia*, and *Thomas*. The asserted *well known prior art* does not cure the previously argued deficiencies in the attempted combination of *Imaeda*, *Kelkar*, *Piikivia*, and *Thomas*.

Moreover, Applicant separately argues the patentability of claims 9 and 10. Specifically, claim 9 recites that the server resides in another mobile terminal (¶¶ [0130], [0131]). The proper cited references are silent with respect to this feature. Claim 10 recites “hot-swapping the interchangeable memory with another interchangeable memory without powering the mobile terminal off (¶ [0014]).” A SIM card simply cannot be hot-swapped, since doing so will turn off the mobile terminal and the communication connection.

Based upon the foregoing, even if the proper applied references are combined as proposed by the Examiner, and again Applicant does not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicant, therefore, submits that the imposed rejection of claims 10 and 30 under 35 U.S.C. §103 for obviousness predicated upon *Imaeda* in view of *Kelkar*, *Piikivia*, and *Thomas* and the asserted *well known prior art* is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-822-7186 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. §1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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Date

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